UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,015	10/26/2001	Patrick R. Clark	01-330	4131

719 7590 10/15/2008

Caterpillar Inc.
Intellectual Property Dept.
AH 9510
100 N.E. Adams Street
PEORIA, IL 61629-9510

EXAMINER	
AKINTOLA, OLABODE	
ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
10/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/016,015	CLARK ET AL.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32,35 and 37-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32,35 and 37-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claims 1-21, Examiner asserts that said method steps could be performed by merely mental steps (e.g. can be performed by mental process or human intelligence alone). Here, Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

Claim 22-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter

Claims 22-31 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor).

Functional descriptive material, per se, is not statutory. This is exemplified in In re Warmerdam 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Claim 42 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 42 recites in the preamble "a computer program product for automatically creating a list of financial documents for a transaction, the computer program product, comprising". The body of claim 42 recites "code means". Therefore claim 42 is non-statutory because it is directed towards software, per se, lacking storage on a medium, which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 6, 8, 10, 11, 22-23, 27, 29, 31 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bierenbaum (USPN 6961708) in view of Miller et al (USPN 5446653)/Rappaport (USPAP 20020007285)/Regan (USPN 6898574).

Re claims 1, 2, 6, 8, 10, 11, 22-23, 27, 29, 31 and 42: Bierenbaum teaches a computer based system and method including the steps of: requesting a decision criteria document (col. 25, lines 5-6; "*request for loan application*"); preparing the decision criteria document, the decision criteria document having a plurality of data fields as a function of the initial information (col. 25, lines 7-9; "*loan application with basic customer information filled in*"); receiving completed data fields (col. 25, lines 14-15; "*accept a completed application from client system*"); requesting initial information in response to the request for a decision criteria document (col. 25, lines 9-12; col. 27, lines 6-10); receiving the initial information; wherein the data fields of the decision criteria document are determined as a function of the initial information (col. 25, lines 14-15). Bierenbaum does not explicitly teach developing a set of selection criteria and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents. Miller/Rappaport/ Regan teaches these concepts (Miller: abstract; Rappaport: Page 15, (claim 33); Regan: col. 2, lines 50-64, col. 7, lines 37-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bierenbaum to include these features for the obvious reason of generating only the relevant documents necessary to process the loan application.

Claims 3-5, 9, 12-16, 18-21, 24-26, 30, 32, 35, 37, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bierenbaum in view of Miller/Rappaport/ Regan in view of Sinclair (USPN 6208979).

Re claims 3-5, 12-16, 18-21, 24-26, 32, 35, 37, 39, 41: Bierenbaum is a discussed above in claim 1. Bierenbaum does not explicitly teach inserting transaction information by a user, wherein the initial information is automatically determined from the transaction information; wherein the initial information includes a contract type, a country code and a lessor number.
Sinclair in the same field of art teaches inserting transaction information by a user, wherein the initial information is automatically determined from the transaction information; wherein the initial information includes a contract type, a country code and a lessor number (col. 6, lines 60-65; col. 7, lines 38-43); and generating and forwarding the necessary documents to finalize a transaction (col. 9, lines 5-9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bierenbaum to include this feature for the obvious reason of retrieving information on the customer based on the basic customer information filled in.

Re claims 9, 19, 30 and 40: Bierenbaum and Miller/Rappaport/ Regan do not explicitly teach wherein each document in the list of financing documents includes a document name, a number of copies, and a simplex/duplex code. However, Sinclair teaches generating necessary documents (col. 9, lines 5-6). Official notice is hereby taken that it is old and well known to have in a list of necessary document, the document name, number of copies and codes. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bierenbaum to

include the document name, number of copies and codes as part of the requirement of tracking purposes.

Claims 7, 17, 28 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bierenbaum in view of Miller/Rappaport/ Regan in view of Sinclair in view of Fletcher et al (USPN 6112190).

Re claims 7, 17, 28 and 38: Bierenbaum, Miller/Rappaport/ Regan and Sinclair do not explicitly teach the step of allowing a user to override the required set of documents. Fletcher teaches the step of allowing a user to override the required set of documents (col. 11, lines 34-37); creating and generating relevant documents relating to a loan application (col. 12, lines 8-16; col. 3, line 64 through col. 4, line 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bierenbaum to include this step as taught by Fletcher. One would have been motivated to do so in order to allow the user to make changes as may be deemed necessary by overriding the document.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gupta et al (USPN 6199079) teaches a method for automatically filling forms in an integrated network based transaction environment (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691